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Patents and Trademarks

January 9, 2007

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Response to Notification of
Non-Compliant Appeal Brief
Serial No.: 10/608,054
Filed: June 27, 2003
For: GIFT DISPLAY BOX
Our ref: TRA-007 (Michael L.F. Chan)

Dear Sir or Madam:

In response to the Notification of Non-Compliant Appeal Brief mailed 12/12/2006 from the Patent and Trademark Office regarding the above-identified patent application, enclosed is Applicant-Appellant's Amended Brief, in triplicate. No substantive changes have been made in the brief. The Amended Brief is intended as a substitute for Applicant-Appellant's Opening Brief which did not comply with PTO rules and is now withdrawn.

Respectfully submitted,

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

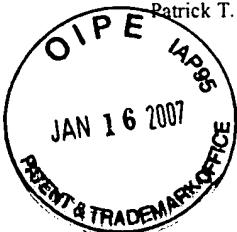
Signed: Merle P. Garcia
Typed Name: Merle P. Garcia
Date: January 9, 2007



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Encl: Amended Brief (in triplicate)
cc: Michael Chan w/encl.

BEST AVAILABLE COPY





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Michael L.F. Chan PATENT APPLICATION
Serial No: 10/608,054 Group Art Unit: 3725
Filed: June 27, 2003 Examiner: B.B. Miller
Confirmation No.: 7895 Atty. Docket No.: TRA-007
For: GIFT DISPLAY BOX

APPLICANT-APPELLANT'S AMENDED BRIEF



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Michael L.F. Chan

PATENT APPLICATION

Serial No: 10/608,054

Group Art Unit: 3725

Filed: June 27, 2003

Examiner: B.B. Miller

Confirmation No.: 7895

Atty. Docket No.: TRA-007

For: GIFT DISPLAY BOX

Introduction

This is an appeal of the final rejection of claim 19 of the above-identified patent application. The final rejection was mailed on February 22, 2006. A first Advisory Action was mailed on June 26, 2006 and a second Advisory Action was mailed on July 10, 2006. As required under 37 C.F.R. § 41.37(a), Applicant-Appellant's Opening Brief was filed within two months of the date of filing of the Notice of Appeal (June 23, 2006).

Appellant received a Notification of Non-Compliant Appeal Brief mailed on December 12, 2006 indicating that the Opening Brief was defective for failure to comply with one or more provisions of 37 C.F.R. § 41.37. Specifically, the

Notification of Non-Compliant Appeal Brief indicated that the Opening Brief did not contain a statement of status of all the claims, as required under 37 C.F.R. § 41.37(c)(1)(iii), and that the Opening Brief did not contain a concise explanation of the subject matter defined in each of the independent claims in the appeal, referring to the specification by page and line number and to the drawings, if any by reference characters. In response Appellant submits that Applicant-Appellant's Amended Brief remedies the above-mentioned defects. Also, Appellant has updated the Status of Amendments in the Amended Brief herewith. The Amended Brief is submitted within a timely manner, i.e. within one month of the date of mailing of the Notification of Non-Compliant Appeal Brief. Therefore, Appellant respectfully submits that the Amended Brief is in compliance with the provisions of 37 C.F.R. § 41.37.

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Real Party in Interest

The real party of interest is Michael L.F. Chan.

Related Appeals and Interferences

There are no prior or pending appeals, judicial proceedings, interferences for commonly-owned applications having common subject matter or claim to a common priority application known to either Appellant or the real party in interest which may be related to, directly effect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Independent claim 19 of the above-identified application was rejected and is being appealed herewith. Claim 19 was finally rejected in the Office action of February 23, 2006 and that rejection is being appealed herewith. Claims 1-18 were cancelled and claims 20-23 were withdrawn from consideration. Thus, claim 19 is the only claim being appealed.

Status of Amendments

An amendment was filed on July 25, 2006 to amend claim 19 to correct an informality identified by the Examiner in an Advisory action dated July 10, 2006 and to present the claim in better form for consideration on appeal. According to the Examiner's Answers prepared by Bena Miller on November 6, 2006 and on December 28, 2006, this amendment has been entered.

Summary of Claimed Subject Matter

Appellant's independent claim 19 recites a device for display of a gift that is suitable for mailing. Appellant's specification, page 1, lines 32-33; page 2, lines 5-6. The device comprises "an inner box of rectangular cross section" (Appellant's specification, page 1, lines 32-33; Fig. 1, reference numeral 10 corresponds to inner box), "having dimensions for accommodating a gift therein" (Appellant's specification, page 1, lines 32-33; Fig. 1, reference numeral 16 corresponds to display item) and "having a transparent wall through which said gift is visible..." (Appellant's specification, page 2, lines 29-32; page 3, line 24; Fig. 1, reference numeral 15 corresponds to top transparent surface). Also, the device includes, "an outer box...having dimensions for snug nesting of the inner box" (Appellant's specification, page 3, lines 7-9; Fig. 1, reference numeral 26 corresponds to outer box) and the outer box "having a cutout region in the one of the opposed top and bottom sections through which the inner box is visible" (Appellant's specification, page 3, lines 10-12; Fig. 1, reference numeral 30 corresponds to cutout). Thus, the gift displayed in the inner box is visible when the inner box is nested within the outer box. (Appellant's specification, page 3, lines 10-14).

Grounds of Rejection to Be Reviewed on Appeal

The following are the grounds of rejection to be reviewed in this appeal:

1. Is claim 19 patentable under 35 U.S.C. § 102(b) over U.S. Patent No. 1,860,586 to McIlhenney?

Arguments

I. Claim 19 is Patentable Under 35 U.S.C. § 102 (b) Because McIlhenney Fails to Teach Each Element of this Claim

Claim 19 is not anticipated by McIlhenney. In order to anticipate a claim, a reference must teach all of the elements of the claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F. 2d 628, 631 (Fed. Cir. 1987). The reference must show the claimed invention "in as complete detail as is contained in the patent claim" in order to anticipate the claimed invention. Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236 (Fed. Cir. 1989). McIlhenney fails to teach all of the elements of Appellant's claim 19 as in complete detail as contained in its claim. Therefore, the claims are not anticipated and are novel.

A. McIlhenney Fails to Teach all the Elements of Appellant's Claim 19

McIlhenney fails to anticipate Appellant's claim 19 because it fails to teach all elements of Appellant's claim 19. In the Office action of February 22, 2006, the Examiner erroneously asserted that, "[t]he device of McIlhenney reads on the structural limitation of the claims including an inner box (the combination of 11 and 12)...." Office action, at 2. McIlhenney does not teach the inner box as claimed in claim 19.

Therefore, McIlhenney fails to anticipate Appellant's claim 19.

Specifically, McIlhenney fails to teach Appellant's claimed element of "an inner box of rectangular cross section with opposed top and bottom sections...", as recited in claim 19. Instead, McIlhenney recites, "[t]he candy or other contents of the box will be packed in a tubular member 12...." McIlhenney, col. 2, lines 76-77. The Examiner has erroneously asserted that the tubular member 12 of McIlhenney is an inner box, as recited in Appellant's claim 19.

A "tubular member" is not a box. Oxford's Compact English Dictionary Online defines a box as "a container with a flat base and sides and a lid." McIlhenney's "tubular member" suggests the 3-sided cardboard dividers found in confectioner's samplers. Figures 1-3 and 6-8 of McIlhenney clearly show an outer box, but do not disclose any details of the "tubular member." McIlhenney does not teach, or even suggest, that the tubular member 12 has a flat base, sides, and a lid, much less "an inner box of rectangular cross section with opposed top and bottom sections..." as recited in Appellant's claim 19. As McIlhenney does not teach this element of Appellant's claim 19, McIlhenney fails to anticipate the claimed invention.

Further, McIlhenney fails to teach Appellant's claimed element of "said inner box having a transparent wall through which said gift is visible", as recited in claim 19 (emphasis

added). McIlhenney recites, "[t]he candy or other contents of the box will be packed in a tubular member 12 and entirely wrapped and sealed in a transparent paper or sheet cellophane 11 as illustrated in Figure 6." McIlhenney, col. 2, lines 76-80. The transparent paper or sheet cellophane 11 of McIlhenney is not a transparent wall of an inner box recited in Appellant's claim 19. McIlhenney's "tubular member" "wrapped and sealed in a transparent paper or sheet cellophane" does not read on Appellant's "transparent wall." Instead, transparent paper or sheet cellophane is a covering of the tubular member 12.

For the sake of argument, even if the tubular member 12 of McIlhenney were considered to be an inner box, McIlhenney does not teach or even suggest that the inner box has a "transparent wall." It only discloses a transparent paper or sheet cellophane which is a covering of tubular member 12, not a transparent wall of an inner box.

To further emphasize the difference between transparent paper or sheet cellophane and a transparent, inner box wall, Appellant submits that transparent paper or sheet cellophane may not be removed in the same manner as a box top; once removed, it must be resealed by heat, tape, or glue. In contrast, a box with a transparent wall may be opened, the contents removed and replaced, then closed without glue or tape. As McIlhenney does not teach an "inner box having a transparent wall," (emphasis

added) as required by Appellant's claim 19, McIlhenney does not anticipate claim 19.

B. Appellant's Product, Based on the Claimed Invention, has Achieved Commercial Success

Appellant submitted the Declaration of Michael L.F. Chan Under PTO Rule 1.132 ("Declaration") in response to the Office action dated October 11, 2005 in the event that an obviousness rejection was to be made subsequent to Appellant's response. Though the Examiner never made an obviousness rejection, the Examiner responded to the Declaration in the Advisory Action Before Filing of an Appeal Brief dated July 10, 2006 and in the Advisory Action Before Filing of an Appeal Brief dated June 26, 2006. In order to provide a thorough response to the Advisory Actions, Appellant, without conceding that an obviousness rejection was even made, responds to the Examiners assertion as follows.

In responding to Appellant's submission of the Declaration, the Examiner stated that, "an Applicant who is acceding commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and the evidence of commercial success." Advisory Action Before the Filing of an Appeal Brief, dated July 10, 2006. Further, the Examiner, citing a Federal

Circuit case, stated that “[t]he term ‘nexus’ designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness.” Advisory Action Before the Filing of an Appeal Brief, dated July 10, 2006 (citing *Demaco Corp. v. F. Von Langsdoe Licensing Ltd.*, 851 F.2d 1387 (Fed Cir. 1988)).

In response, Appellant submits that *Demaco* states, “[a] prima facie case of nexus is generally made out when the patentee shows both that there is commercial success, and the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.” *Demaco* at 1392. First, Appellant submits that Appellant’s Declaration indicates a showing of commercial success. As stated in the Declaration, Appellant sold approximately 10,000 gift display boxes since 2003, thus indicating commercial success. Further, Appellant submits that the only advertising for the claimed product was the order catalogue thus indicating the great likelihood that marketing and advertisements are not responsible for the commercial success and instead indicating that the merits of the product itself are responsible for the commercial success. Second, Appellant submits that its commercially successful product is Appellant’s claimed invention disclosed in its patent application. Appellant’s claim recites, “an inner box of

rectangular cross section with opposed top and bottom sections having dimensions for accommodating a gift therein, said inner box having a transparent wall through which said gift is visible, an outer box with opposed top and bottom sections having dimensions for snug nesting of the inner box by ingress through an end of the outer box between the top and bottom sections, the outer box having a cutout region in the one of the opposed top and bottom sections through which the inner box is visible."

Appellant submits that all of these elements are present in the product displayed in the order catalogue submitted with the Declaration. Thus, Appellant submits that the commercially successful product shown in the order catalogue is Appellant's claimed invention disclosed in its patent application. Thus, Appellant submits that it has met its burden of proof as it has established a nexus between the claimed invention and the evidence of commercial success.

Accordingly, for at least the reasons submitted above, Appellant submits that its claimed product is commercially successful.

Claims Appendix

19. A device for display of a gift item suitable for mailing comprising,

an inner box of rectangular cross section with opposed top and bottom sections having dimensions for accommodating a gift therein, said inner box having a transparent wall through which said gift is visible,

an outer box with opposed top and bottom sections having dimensions for snug nesting of the inner box by ingress through an end of the outer box between the top and bottom sections, the outer box having a cutout region in the one of the opposed top and bottom sections through which the inner box is visible.

Evidence Appendix

1. Declaration of Michael L.F. Chan Under PTO Rule 1.132

Related Proceedings Appendix

None

Relief Sought

Appellant believes that the pending claim rejected by the Examiner defines a patentable invention that is novel, and even non obvious, over the cited reference for at least the reasons set forth above. Accordingly, Appellant respectfully requests that the Examiner's rejection be reversed.

Respectfully submitted,

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signed: Merle P. Garcia
Typed Name: Merle P. Garcia

Date: January 9, 2007


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael L.F. Chan
Serial No.: 10/608,054
Filed: June 27, 2003
Confirmation No.: 7895
For: GIFT DISPLAY BOX

PATENT APPLICATION
Group Art Unit: 3725
Examiner: Bena B. Miller
Attorney Docket No.: TRA-007

Declaration of Michael L.F. Chan
Under PTO Rule 1.132

1. I am the applicant in patent application Serial No. 10/608,054.
2. Attached as Exhibits 1-6 are order catalog pages showing the gift display box that is the subject of the above-identified patent application.
3. I have made and/or sold approximately 10,000 gift display boxes mentioned in paragraph 2 since 2003 without any advertising except for my order catalog.
4. I believe that U.S. patent protection is necessary to protect my investment in manufacture and sales of the gift display boxes mentioned in paragraph 2.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false

statements may jeopardize the validity of the application or
any patent issuing thereon.

Date: 10/15/2005


MICHAEL L.F. CHAN



TL Ready-to-Mail™ (in 10 Seconds)



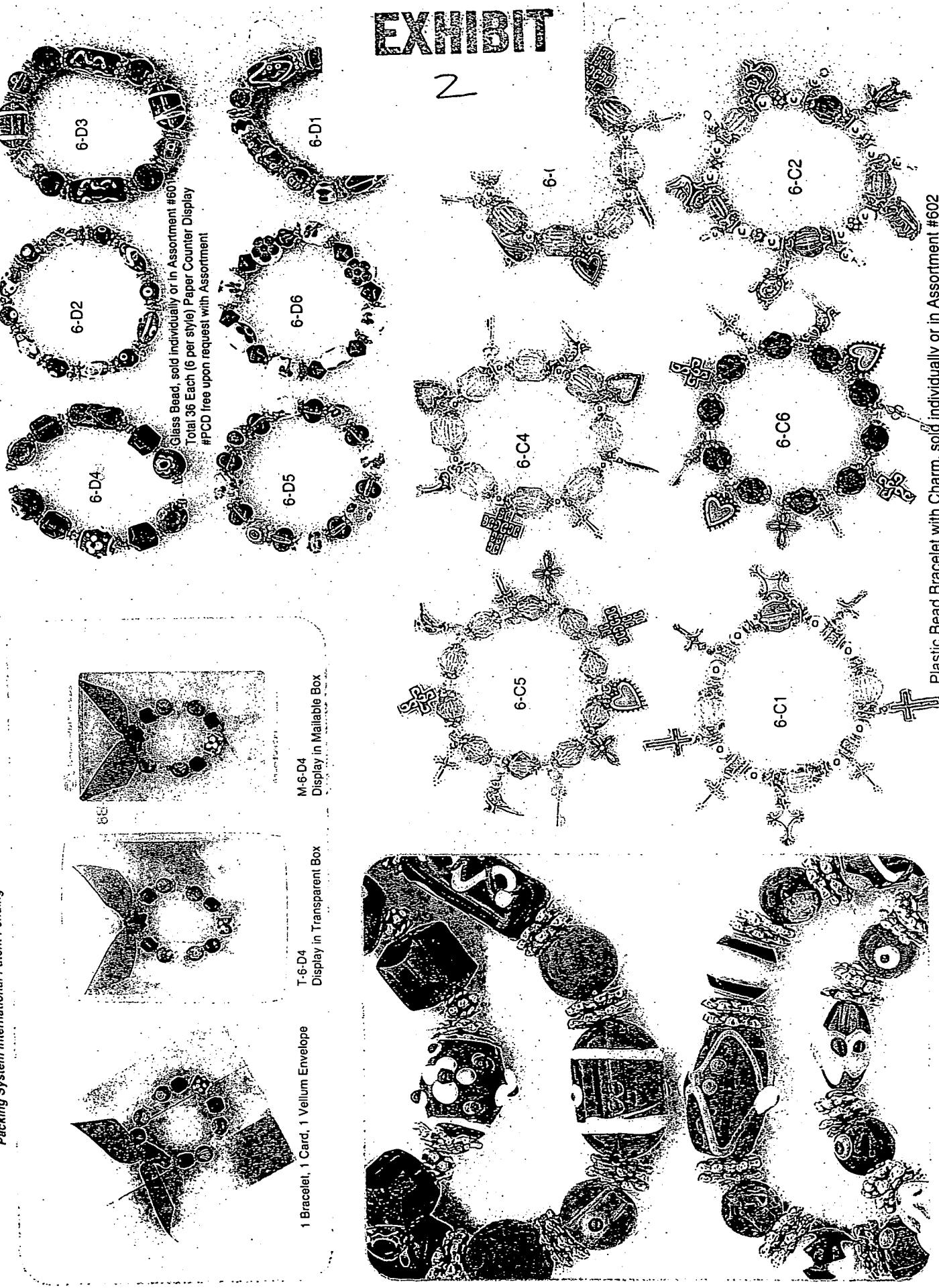
EXHIBIT

1

Gift with Blank Card (For All Occasions)

.....
or in Mailable Box (precede item # by M) Ready-to-mail in 10 Seconds
Packing System International/ Patent Pending

Tel: 510-527-4008 Fax: 510-524-5062
E-Mail: office@translinkcorporation.com
Web: www.translinkcorporation.com



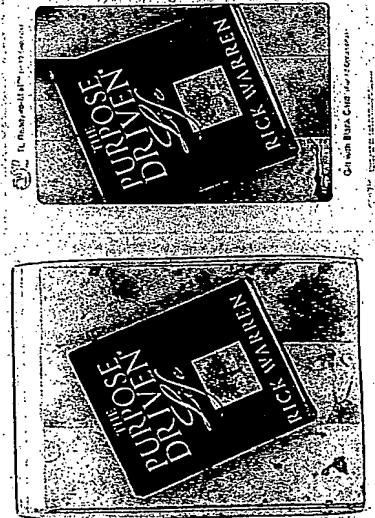
The Good, The True and The Beautiful Collection (GTB Collection)

Gift with blank card plus optional mailer to mail in 10 seconds
Choose from 100 plus books combined with gift of matching assorted colors
(unless specific color is requested)

Packing System
International Patent Pending

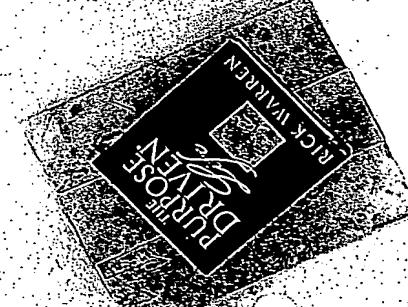
Translink Corporation
1201 10th Street, Berkeley, CA 94710

Tel: 510-527-4008
Fax: 510-524-5062
E-mail: office@translinkcorporation.com
Web: www.translinkcorporation.com



T-3-116
Display in Transparent Box
Procedure Item Number by T

1 Book
1 Abstract Flower Sap
1 Design Blank Card
1 Vellum Envelope

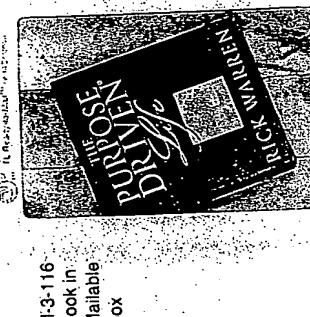


This Display holds one
assortment of 36 books

Instructional Book
Assortment #481

**Free Display available
upon request when
order of books or
off sets by assortment**

Each book or gift set
can also be ordered
individually



卷之三

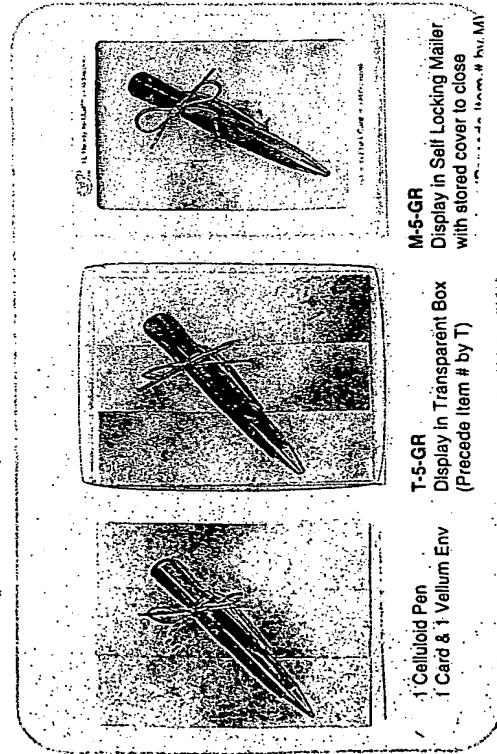
center Disnlay 15" W x 13" D x 10" H

Small 6 x 4 3/4 x 3/4"

Extra Large 9 x 6 x 1 1/8"

The Good, The True and The Beautiful Collection (GTB Collection) Ready-to-mail in 10 Seconds

Selected Gift with 1 Blank Flower Sap Design Card 4 1/2 x 5 1/2" and 1 Vellum Envelope for all occasion In Transparent Box (precede item # by T)
In Mailable Box (precede item # by M) Free Display, with Assortment of 36 Each or more

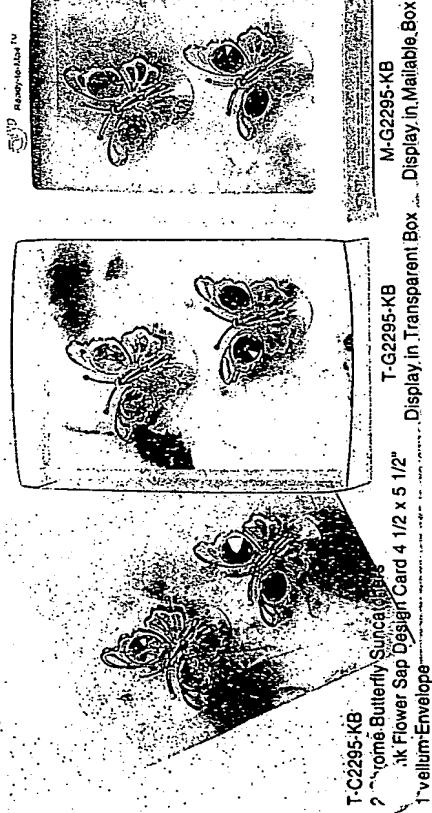
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 E-mail: office@translinkcorporation.com
 Web: www.translinkcorporation.com

<p>T-5-RE Celluloid Ball Point Pen Asst 701 Total 36 Each (6 per color) with Free Display</p> <p>M-5-GR Display in Seal Locking Mailer with stored cover to close</p> <p>T-5-GR Display in Transparent Box (Precede item # by T)</p> <p>T-15-AS Hand Carved, Hand Painted, Refillable Wooden Pen, 1 Card, 1 Env Asst 702 Total 48 Each (12 Mixed Flowers, 12 North American Animals, 12 Mixed Zoo Animals unless specific design on page 32-33 is requested) with Free Display</p> <p>T-16-AS Hand Carved, Hand Painted, Wood Bookmark, 1 Card, 1 Env Asst 703 Total 48 Each (12 Mixed Birds, Flowers and Insects, 12 Mixed Animals, Marine & Miscellaneous unless specific design on Page 49 is requested)</p> <p>T-17-AS Split Shell, 1 Card, 1 Env Asst 706 Total 36 Each (4 style) with Free Display</p> <p>T-18-AS Seed Packet, 1 Card, 1 Env Asst 707 Total 36 Each (3 style) with Free Display</p> <p>T-19-AS Bird Seed Paper Weight Asst 708 Total 36 Each (3 style) available free upon request with Assortment purchase</p> <p>T-20-AS Small Shells Paper Weight Asst 709 Total 36 Each (3 style) with Free Display</p> <p>T-21-AS Mineral Stone Paper Weight Asst 710 Total 36 Each (3 style)</p>	<p>T-15-AS 24K Gold Plated Bookmark Asst 704 Total 36 Each (4 per style) with Free Display</p> <p>T-W822 24K Gold Plated Wind Chime Asst 705 Total 36 Each (4 per style) with Free Display</p> <p>T-16-AS Hand Carved, Hand Painted, Wood Bookmark, 1 Card, 1 Env Asst 706 Total 36 Each (4 style) with Free Display</p> <p>T-17-AS Split Shell, 1 Card, 1 Env Asst 707 Total 36 Each (3 style) with Free Display</p> <p>T-18-AS Bird Seed Paper Weight Asst 708 Total 36 Each (3 style) with Free Display</p> <p>T-19-AS Small Shells Paper Weight Asst 709 Total 36 Each (3 style) with Free Display</p> <p>T-20-AS Mineral Stone Paper Weight Asst 710 Total 36 Each (3 style)</p>
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**Suncatcher (24K Gold Plated or Chrome Plated with Clear or Color Austrian Crystal) With
1 Blank Flower Sap Design Card and 1 Vellum Envelope for all occasion
In Transparent Box (precede item # by T) or in Mailable Box (precede item # by M)
Packing System International Patent Pending
Ready-to-mail in 10 Seconds**

Translink Corporation
1201 10th Street, Berkeley, CA 94710
Tel: 510-527-4008 Fax: 510-524-5062
E-mail: office@translinkcorporation.com
Web: www.translinkcorporation.com



T-C2295-KB

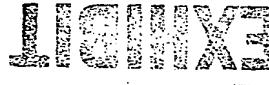
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Blank Flower Sap Design Card 4 1/2" x 5 1/2"
1 vellum Envelope

M-G2295-KB

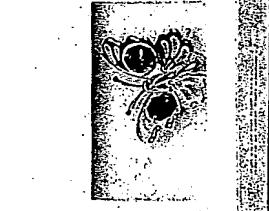
Display in Transparent Box
Display in Mailable Box

Slide in cover stored at back
to close window

Front being



Front being



Front being



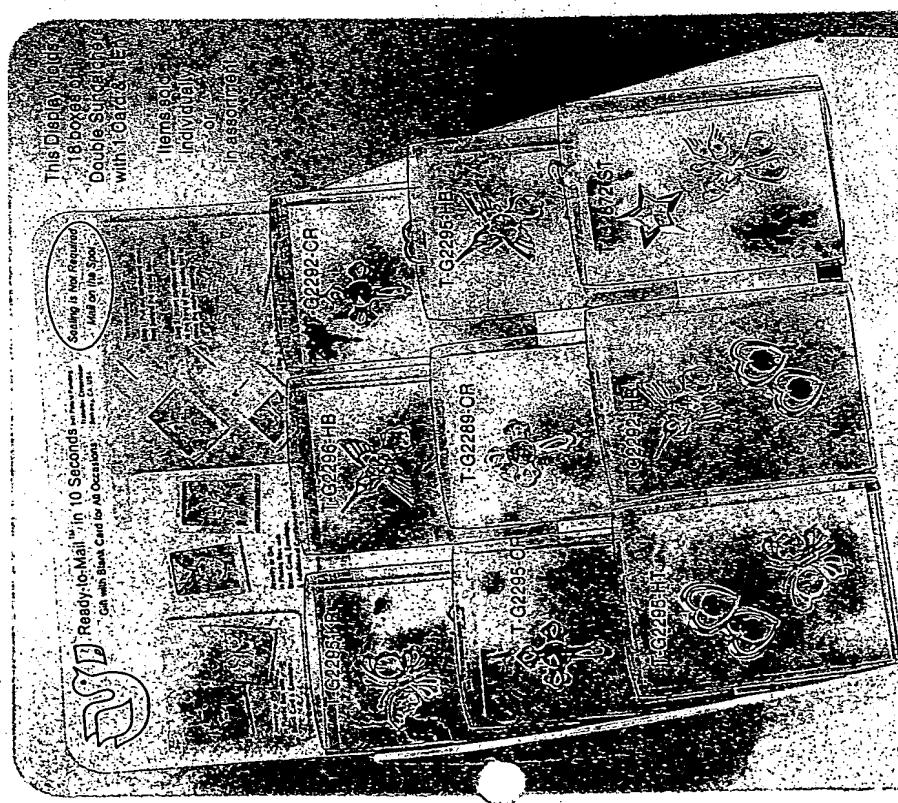
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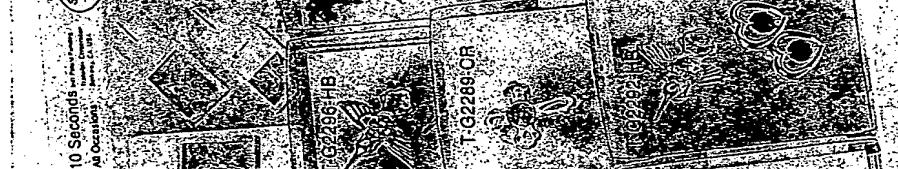
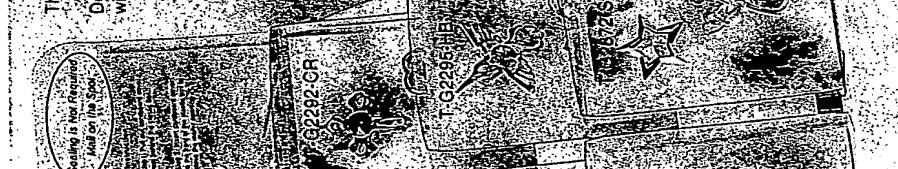
Front being



Front being



24K Gold Plated Suncatchers: 9 styles, sold by individual style
or as Assortment #501 Total 36 Each (4 per style)



Translink Corporation

1201 10th Street, Berkeley, CA 94710
Tel: 510-527-4008 Fax: 510-524-5062
E-mail: office@translinkcorporation.com
Web: www.translinkcorporation.com



Ready-to-Mail™

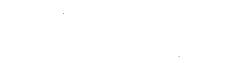
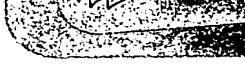
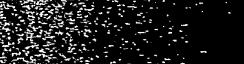
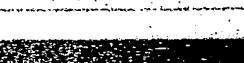
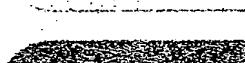
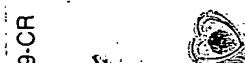
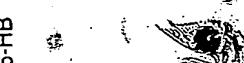
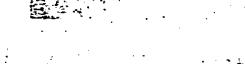
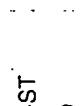
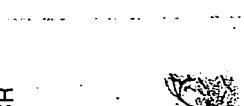
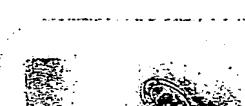
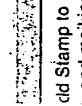
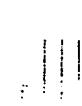
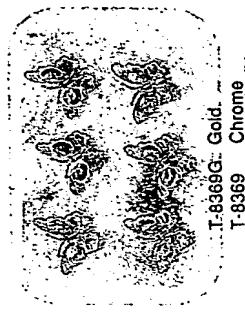
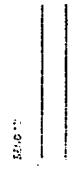
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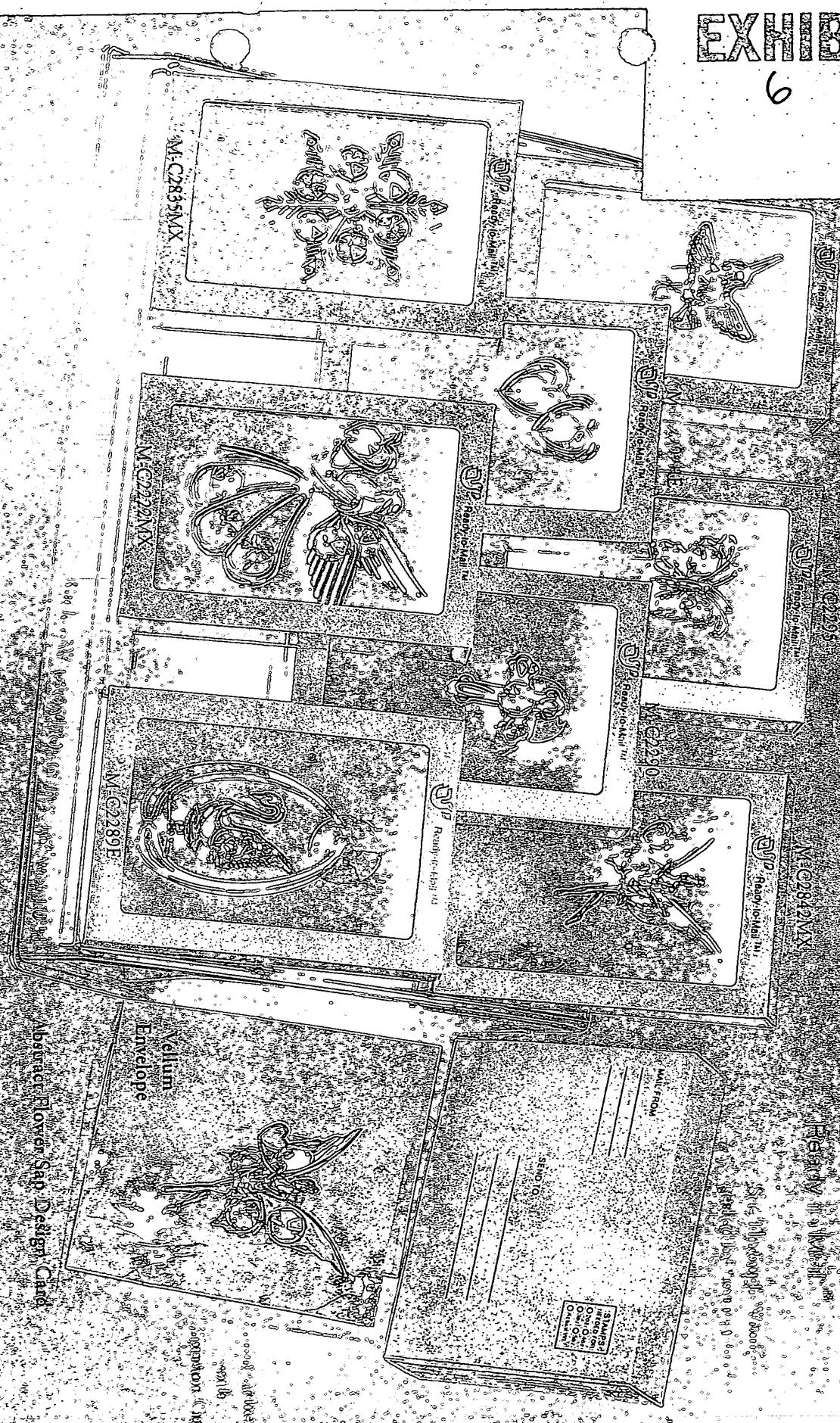
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EXHIBIT

6

Envelopes shown below include:
"Crystal Delight Sun Catcher"
(Jewel Tone Colors)
(Available June 2000)



Floral Flower Seal Design Card

TRANSLINK CORPORATION

1201 10th Street, Berkeley, CA 94710

Assist
Assist
Assist

1-510-527-4008 (Fax 510-524-5062)
e-mail office@translinkcorporation.com

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